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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,384	02/29/2000	Mary Ellen Zurko	C99021US	1649

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EXAMINER

DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

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DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,384

Applicant(s)

ZURKO ET AL.

Examiner

Justin T. Darrow

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-28 have been presented for examination. Claims 1-20 have been canceled in a preliminary amendment filed 02/29/2000. Claims 21-28 have been examined.

Priority

2. Acknowledgment is made that the instant application is a division of Application No. 07/479,666, filed 02/13/1990, now U.S. Patent No. 6,507,909 B1.
3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 121 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Res Judicata

4. In the letter attached with the information disclosure statement, filed 09/12/2001, Paper No. 4, page 2, lines 3-14, the applicant, citing *Pfaff v. Wells Electronics*, 5 F.3d 514, 518 (Fed. Cir. 1993), states the Office may be estopped from rejecting claims 21-25 and 27 based on the combination of the references, UNIX Operating System and Dunford, "Filer, Version 2.20 User Documentation," because of the judgment reversing the rejection of claims 1, 4, and 5 of

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Application No. 07/479,666 under 35 U.S.C. 103(a) based on these references in *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

Res judicata does not apply when the claims at issue in the child application are different from those in the previously adjudicated parent application. See MPEP § 706.03(w); *In re Fried*, 136 USPQ 429, 431 (C.C.P.A. 1963). Additionally, in the situation of different claims in the divisional application, the grounds of rejection of the claims in this application may be based on the same statutory basis, such as 35 U.S.C. 103(a), and the combination of the same references, but supported by different reasoning than that used to reject claims in the previously finally judged parent application. See *In re Hellbaum*, 152 USPQ 571, 572 (C.C.P.A. 1967). In *Pfaff*, res judicata was limited to the issue of claim construction of the same claims at issue in both infringement actions. See *Pfaff*, 28 USPQ2d 1119, 1121 (Fed. Cir. 1993). The instant application is distinguished from *Pfaff* in that the claims at issue are different from those in the parent case.

In the instant application, claims 21-25 and 27 are the same as claims 10-14 and 16, respectively, of Application No. 07/479,666. They are patently distinct from claims 1, 4, and 5 of Application No. 07/479,666 because they represent subcombinations useable together. See MPEP § 806.05(d) and Paper No. 17 of Application 07/479,666, mailed 07/21/1993. Further, claims 21-25 are also differentiated from claims 1, 4, and 5 of Application No. 07/479,666 with the additional limitation, "(a) upon login by a user, assigning a process identifier to the user in the trusted computing environment." Claim 27 is distinguished from claims 1, 4, and 5 of Application No. 07/479,666 because it lacks the limitation "(a) displaying a representation of the

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parsed command to the user through a trusted path.” In view of this, res judicata does not apply to claims 21-25 and 27.

Drawings

5. This application lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. The formal drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for formal drawings will not be held in abeyance.

Double Patenting

6. Claim 28 is objected to under 37 CFR 1.75 as being an exact duplicate of claim 26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Atalla, U.S. Patent No. 4,315,101 A.

As per claims 21, 24/21, 25/21, 26/21, and 28/21, Atalla illustrates a method, an automatic data processing machine programmed to execute a method, an automatic data processing machine comprising means for performing a method, and program storage devices readable by machine and tangibly embodying a representation of a program of instructions adaptable to be executed by the machine to perform a method for verifying the existence of a trusted path, comprising:

(a) upon login by a user (see column 6, lines 58-60; figure 6, items 87 and 83; the authorized person introduces his PIN via keyboard), assigning a process identifier to the user in the trusted computing environment (see column 7, lines 35-43; figure 6, items 97 and 101; outputting ACK-TRAC at the remote location; see column 8, lines 7-12; figure 6, items 109 and 107; where the ACK-TRAC signal is an indication of the completion of the transaction);

(b) storing the assigned process identifier in trusted memory (see column 6, lines 39-42; figure 4A, item 65; storing control words in the remote station);

(c) establishing a trusted path between the user and the trusted computing environment (see column 7, lines 35-41; figure 6, items 97, 101, and 121; sending the ACK-TRAC signal from the encryption module; see column 9, lines 21-34; where acknowledgments are transmitted with substantial security against errors and unauthorized alterations);

(d) through the trusted path, displaying the process identifier to the user (see column 8, lines 7-12; figure 6, item 110; output is generated upon favorable comparison of the two ACK-

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TRAC signals in the comparator is an indication of completion of the transaction which was initiated by the individual); and

(e) upon the user's subsequent entry into the trusted environment, displaying the process identifier to the user through the trusted path (see column 8, lines 31-44; an authorized individual is able to control a transaction with the aid of previously established files in the correspondent office; see column 8, lines 7-12; figure 6, item 110; output is generated upon favorable comparison of the two ACK-TRAC signals in the comparator is an indication of completion of the transaction which was initiated by the individual).

As per claims 22, 24/22, 25/22, 26/22, and 28/22, Atalla further elaborates:

that the process identifier is a randomly generated group of alphanumeric characters (see column 3, lines 44-49; figure 1A, items 13 and 15; a user identifier code produced from a random number).

As per claims 23, 24/23, 25/23, 26/23, and 28/23, Atalla additionally suggests:

That the process identifier is pronounceable (see column 6, lines 50-57; figures 5A and 5B, items MSGE and SEQ; that ACK-TRAC is encrypted from the message, such as an account number, combined with a sequence number, such as date and time, all pronounceable pieces of data).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 27 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Atalla, U.S. Patent No. 4,315,101 A in view of National Institute of Standards and Technology, "DES Modes of Operation."

As per claim 27, Atalla depicts an apparatus for executing a trusted command that is issued by a user and that is parsed by untrusted means to generate a parsed command (see column 6, lines 50-57; figures 5A and 5B, items MSGE and 83; a message indicating the type of transaction supplied to an encryption algorithm module; see column 4, lines 50-59; column 6, lines 61-64; incorporating the National Bureau of Standards' encryption-decryption algorithm which is the Federal Information Processing Standard approved by the U.S. Department of Commerce, the Data Encryption Standard (DES)), comprising:

(a) trusted means for receiving the encrypted command via a trusted path (see column 7, lines 1-7; figure 6, item 89; transmitting the encrypted message as TRAC signal over a data link; see column 9, lines 29-34; where the instructions required to command a transaction are transmitted with substantial security against errors and unauthorized alterations, and with ample provisions for auditable records of the transaction);

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(b) means for displaying a representation of the parsed command to the user for verification (see 7, lines 35-41; figure 6, items 97 and 101; the ACK-TRAC signal resulting from the encrypted message; see column 8, lines 7-12; figure 6, item 107 and 110; where the ACK-TRAC undergoes a comparison, the favorable output from which indicates the initiating individual that the transaction has completed); and

(c) trusted means for executing the verified encrypted command (see column 8, lines 25-36; controlling the the transaction with the aid of the central office).

Atalla does not explicitly disclose the feature of parsing to generate a parsed command. However, this feature is deemed to be inherent to the apparatus of Atalla because the DES encryption algorithm requires dividing the data to be encrypted into 64-bit blocks.

National Institute of Standards and Technology, "DES Modes of Operation" elaborates: parsing to generate a parsed command (see Section 1.1 Definitions, Abbreviations, and Conventions. DES INPUT BLOCK: a block that is entered into the DES device for either encryption or decryption of 64 bits in length). Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Atalla with the parsing of the National Institute of Standards and Technology to map all possible 64-bit vectors onto itself (see Appendix A, ¶ 6).

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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January 26, 2004

Justin T. Darrow
JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100